

REMARKS

Applicants respectfully request reconsideration and allowance of the application.

I. CLAIMS STATUS

Claims 22 and 33 have been amended to more particularly point out the invention. Claim 35 has been cancelled without prejudice or disclaimer. New claim 42 has been added. No new subject matter has been added. After entry of this amendment, claims 22 – 34 and 36 – 42 remain pending.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

Per the Final Office Action, claims 22 – 25, 27 – 29 33 – 35 and 37 – 38 stand rejected under Section 103(a) as being obvious in view of U.S. Patent 6,588,748 (“Solow”) and U.S. Patent 4,641,840 (“Larson”); claims 26 and 36 stand rejected under Section 103(a) as being obvious in view of Solow, Larson and U.S. Patent 3,755,241 (“Brady”); and claims 30 – 31 and 39 - 40 stand rejected under Section 103(a) as being obvious in view of Solow, Larson and U.S. Patent 6,394,903 (“Lam”). Applicants respectfully traverse these rejections and request their withdrawal for at least the following reasons.

A. Prima Facie Obviousness Has Not Been Established Because the Cited References Fail to Teach or Suggest All of the Claimed Features

Independent claims 22 and 33 each recite features that are neither taught nor suggested by the cited references, either alone or in combination. Claims 22 and 33 each recite a COB-mounted IC as part of the electronic circuit contained within the electronic die. Specifically, claim 22 recites “[an] IC being COB-mounted to a printed circuit board (PCB) for miniaturizing the electronic circuit”. Claim 33 recites similar language. In no instance do the cited references teach or suggest this feature of claims 22 and 33. For at least this reason, claims 22 and 33, as well as claims 23 – 32, 34, and 36 - 41 by their respective dependency, are patentable over the cited references.

In addition, claim 33 recites:

“at least one light source, attached to a printed circuit board (PCB) contained internally within the shell, for illuminating the pips;

a light pipe located within the shell and having an end attached to the at least one light source and one or more fingers terminating on the exterior of the shell at one or more of the light-emitting pips, for transferring light from the at least one light source to at least some the light-emitting pips”

Support for the above-quote features may be found in the specification at page 10, lines 6 – 18. The cited references fail to teach or suggest the above-quoted features of claim 33, and therefore, for at least this additional reason, claim 33, as well as claims 34 and 36 – 41 by their dependency, are patentable over the cited references.

B. Modifying Solow to Yield the Die Recited in Claim 22 Would Destroy the Intended Purpose of Solow

Claim 22 recites:

“An electronic gaming die for randomly selecting an outcome that is a number between one and six, comprising:

a six-sided, cube-shaped shell defining the exterior of the electronic die, each side of the cube-shaped shell representing a predetermined outcome that is distinct from the outcomes represented by the other sides of the cube-shaped shell, the cube-shaped shell being adapted to be rolled by a user to determine the outcome”

A proposed modification to a prior art device is not obvious if the modification makes the device inoperative for its intended purpose. MPEP 2143.01; *In re Gordon*, 773 F.2d 900 (Fed. Cir. 1984). In the Final Office Action, the Examiner proposed adding the internal electronic circuit, sensor and battery of Larson to the Solow’s die to allegedly arrive at the electronic die recited in claim 22. Applicants’ respectful submit that such a modification does not meet the standards of obviousness because modifying Solow’s teachings in such a manner would plainly defeat the intended purpose of Solow’s die.

Solow’s dice are novelty items for display purposes only, not for playing games. See Solow, abstract. They are of the same genre as the classic fuzzy dice that hang from

car rearview mirrors. Solow, col. 1, lines 58 – 63. In sharp contrast to Applicants’ die, Solow’s dice are designed to be exclusively powered by an external power source, not an internal battery. In particular, Solow states: “Instead of having an internal battery which is expensive and hard to replace, the illumination of the of the (sic) dots of the present invention is actuated by an external power source such as a cord connected to a jack for plugging into a cigarette lighter.” See Solow, col. 1, line 67 – col. 2, line 4. Indeed, an essential element of Solow’s claimed invention is a “conductor means for electrically connecting said light sources to an external power source.” See Solow, col. 4, lines 2 – 3, 29 – 30 and col. 5, lines 4 – 5. Furthermore, Solow’s dice are designed to hang from their conductor wires on display. Solow, col. 2, lines 54 - 65.

Modifying Solow’s die to be an “electronic gaming die” with a shell adapted to “be rolled by a user to determine the outcome”, as claimed, would require removal of Solow’s external cord. This would destroy the ability to display Solow’s dice by hanging them from their power cords and would defeat Solow’s intent of powering the dice with external sources. Plainly, this would ruin the central purpose of Solow’s dice and teachings. Thus, reliance on Solow’s teachings to somehow render claim 22 obvious is improper.

C. The Cited References Fail to Teach or Suggest All of the Claimed Features of the Dependent Claims

Dependent claims 24 and 34 recite “wherein the shell is transparent and the electronic die further comprises an opaque layer of material disposed on the transparent shell in a predetermined pattern defining the light-emitting pips.” The Office Action states that these features are taught by Solow at figure 2 and col. 3, lines 23 – 28. Office Action at page 5. Applicants’ respectfully disagree. Paraphrasing Solow, Solow teaches that the light-up “dots can be non-opaque integral parts of the material of the otherwise opaque die faces.” Solow, col. 3, lines 24 - 25. This plainly does not teach or suggest the layered shell structure recited in claims 24 and 34, which requires a transparent shell covered by an opaque layer that defines the light-up dots. For at least the foregoing additional reasons, claims 24 and 34 are patentable over the cited references.

III. NEW CLAIM

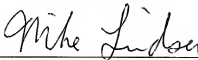
New claim 42 includes the subject matter of claim 32 and its base and intervening claims, in independent form. Claim 32 has been allowed, and thus, claim 42 is in condition for allowance.

IV. CONCLUSION

Each of the pending claims in the application is in condition for allowance and early notice to this effect is earnestly solicited. If, for any reason, the Examiner is unable to allow the application and feels that a telephone conference would be helpful to resolve any issues, the Examiner is respectfully requested to contact the undersigned Applicant at 520-760-8268.

No additional fee is believed to be due with this Response, beyond the RCE and two-month extension of time fees.

Respectfully submitted,



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